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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,852	03/30/2001	Haruhiko Kishi	205041US-6	7025
22850	7590	06/19/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			TRAN, ELLEN C	
			ART UNIT	PAPER NUMBER
			2134	

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/820,852	KISHI ET AL.	
	Examiner	Art Unit	
	Ellen C. Tran	2134	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***DETAILED ACTION***

1. This action is responsive to communication: filed on 23 March 2006 with acknowledgement of with an original application filed 30 March 2001, and of foreign application filing date of 30 March 2000.
2. Claims 1-20 are currently pending in this application. Claims 1, 10, 19, and 20 are independent claims. Claims 1, 10, 19, and 20 have been amended. Amendments to the claims are accepted.

***Response to Arguments***

3. Applicant's arguments filed 23 March 2006 have been fully considered but they are moot due to new grounds of rejection initiated by amendment to all of the independent claims.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Down et al. US Patent No. 6,226,618 (hereinafter '618) in further view of Kambayashi et al. U.S. Patent No. 6,477,649, (hereinafter '649).

**As to independent claim 10, "An information vending method comprising the steps of"** is taught in '618 col. 1, lines 51-56;

**"accumulating information for sale"** is shown in '618 col. 8, line 54 through col. 9, line 60 and col. 48, lines 27-67;

**“generating usage conditions for said information for sale in response to a purchase selection of the information for sale; encrypting said purchase selection; generating a cryptographic key which decrypts said purchase selection”** is disclosed in ‘618 col. 50, line 33 through col. 52, line 32;

the following is not taught in ‘618: **“authenticating a license management capability of a portable recording medium loaded on said information vending apparatus in one of direct and indirect manners; and writing said purchase selection to said portable recording upon authentication along with said usage license management capability and said cryptographic key”** however ‘649 discloses “Contents information is recorded on a recording medium (information medium) such as a DVD-RAM or DVD-ROM. A right for using (reproducing and watching) the contents information under a predetermined condition is called a license. The user obtains license information by purchasing the license. The license information for allowing reproduction of the contents information may be recorded on the recording medium together with the contents information. Alternatively, the license information may be separately recorded on another recording medium or, e.g., an IC card having a memory and an arithmetic function, read out independently of the contents information, and input to the information reproducing apparatus shown in FIG. 107. This license information may be distributed through broadcasting or the Internet ... for checking on the basis of license information corresponding to the encrypted contents whether the license is valid, and if the license is valid, outputting a contents decoding key for the use of the contents information, and an information usage device 7002 such as a DVD player or a video reproduction device for decoding the encrypted contents using the decoding key output from the information media driver 7001 and reproducing the

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contents information ... The license authentication information is a code which is defined in advance to check whether the encrypted license information has been properly decoded” in col. 63 lines 8-54.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify a method for securely distributing data taught in ‘618 to include a means to authenticate a recording medium prior to copying data. One of ordinary skill in the art would have been motivated to perform such a modification to prevent illegal coping of data see ‘649 (col. 1, lines 37 et seq.) “A DVD is a large-capacity personal computer medium replacing a CD-ROM, and various applications to movie, music, game, karaoke, and the like can be expected. For popularization of DVDs, inexpensive DVD titles or spread of a rental DVD market is expected. From these viewpoints as well, it is essential to provide an information distribution system assuming protection by copyright of information, i.e., a system based on a concept of charging not for possession of a digitized work recorded on a recording medium such as a DVD but for use of the digitized work”.

**As to dependent claim 11, “further comprising communicating with a reproduction unit for reproducing said purchase selection recorded on said portable recording medium; wherein in said authentication step, said reproduction unit is further authenticated when in said communication step said reproduction unit is communicated; and in said writing step, said encrypted information for sale along with said usage conditions and said cryptographic key are written to said recording medium through said reproduction unit” is taught in ‘618 col. 7, line 40 through col. 8, line 5.**

**As to dependent claim 12, “wherein said reproduction unit is a portable device and said portable medium being detachably loaded on said portable device” is shown in ‘618 col. 11, lines 29-53.**

**As to dependent claim 13, “wherein in said communication step, said reproduction unit which reproduces said purchase selection recorded on said portable recording medium integrally disposed on said reproduction unit is communicated; and in said writing step, said encrypted purchase selection along with said usage conditions and said cryptographic key are written to said portable recording medium integrally disposed on said reproduction unit” is disclosed in ‘618 col. 7, lines 11-65.**

**As to dependent claim 14, “wherein said reproduction unit is a portable device and said storage medium is fixedly and integrally arranged on said portable device” is taught in ‘618 col. 6, lines 37-48.**

**As to dependent claim 15, “further comprising: receiving said information for sale supplied through a predetermined transmission path; wherein in said accumulation step, said information received by said receiving means is accumulated” is shown in ‘618 col. 26, line 35 through col. 27 line 18.**

**As to dependent claim 16, “wherein said transmission path is the Internet, said information is supplied via the Internet to a server unit, and said information is received from said server unit to be stored in said accumulation step” is disclosed in ‘618 col. 26, line 35 through col. 27 line 18.**

**As to dependent claim 17, “wherein in said usage condition generating step, said usage conditions which are employed by said reproduction unit which reproduces said**

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**purchase selection recorded on said portable recording medium are generated; and in said encryption step, said purchase selection is accessed by use of an algorithm which allows said reproduction unit to decrypt said purchase selection”** is taught in ‘618 col. 7, lines 11-55.

**As to dependent claim 18, “wherein said information for sale includes at least one of program, voice, music, still picture, moving picture, text data”** is shown in ‘618 col. 1, lines 50-57.

**As to independent claim 1**, this claim is directed to the apparatus of the method of claim 10 and is rejected along similar rationale.

**As to dependent claims 2-9**, these claims are substantially similar to claims 11-18 and are rejected along the same rationale.

**As to independent claim 19**, this claim is directed to a program storage medium of the method of claim 10 and is rejected along similar rationale.

**As to independent claim 20, “An information vending apparatus comprising”** is taught in ‘618 col. 1, lines 51-56;

**“an accumulation unit configured to accumulate information for sale”** is shown in ‘618 col. 8, line 54 through col. 9, line 60 and col. 48, lines 27-67;

**“a usage condition generating unit configured to provide usage condition for said information for sale in response to a purchase selection of information for sale; an encryption unit configured to encrypt said purchase selection”** is disclosed in ‘618 col. 50, line 33 through col. 52, line 32;

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**“an encryption key generating unit configured to generate a cryptographic key which decrypts said purchase selection”** is disclosed in ‘618 col. 6, line 65 through col. 7, line 65;

**“an authentication unit configured to authenticate a portable recording medium directly or indirectly loaded on said information vending apparatus; and a writing unit configured to write said purchase selection to said portable recording medium along with said usage conditions for said license management capability and said cryptographic key upon authentication”** is taught in ‘649 col. 63 lines 8-54.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen C Tran whose telephone number is (571) 272-3842. The examiner can normally be reached from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques H. Louis-Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ECT

Ellen Tran  
Patent Examiner  
Technology Center 2134  
12 June 2006

*Jacques H. Louis-Jacques*  
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PRIMARY EXAMINER